

ADMINISTRATIVE PANEL DECISION

Firemex Pty Ltd v Datateq Pty Ltd (deregistered)

1. The Parties

- 1.1 The Complainant is Firemex Pty Ltd (ACN 010 806 774) of 53 Pentex Street, Salisbury, Queensland, 4107. The Complainant is represented by Kenny & Co Solicitors, of Level 5, 316 Adelaide Street, Brisbane, Queensland, 4001.
- 1.2 The Respondent is Datateq Pty Ltd (ACN 125 784 607, deregistered as of 25 October 2009), care of John P Natoli & Associates, 153 Victoria Road, Drummoyne, New South Wales, 2047.

2. The Domain Name and Registrar

- 2.1 The disputed domain name is "firemax.com.au" ("Disputed Domain Name"). The Registrar of the Disputed Domain Name is AusDomains ("Registrar").

3. Procedural History

- 3.1 The Panel is advised that the procedural history of this dispute is as follows:
 - 3.1.1 The complaint was submitted for decision in accordance with the auDRP Policy and Rules which was approved by auDA in 2001 and commenced operation on 1 August 2002 and LEADR's Supplementary Rules (LEADR is the "Provider").
 - 3.1.2 On 16 October 2009, a complaint for the Disputed Domain Name was received by the Provider ("Complaint").
 - 3.1.3 On 19 October 2009, the Provider express posted to the Respondent the dispute notification letter and a copy of the Complaint and notified the auDA of the Complaint via email.
 - 3.1.4 On the same date, the Provider posted to the Registrar a copy of the Complaint and dispute notification letter and requested the Disputed Domain Name be locked. The Registrar confirmed that the Disputed Domain Name was locked on 20 October 2009.
 - 3.1.5 The Provider has listed the Complaint on the LEADR website.
 - 3.1.6 On 3 November 2009, a representative of the Respondent contacted the Provider and requested for an extension of the response due date by 10 calendar days. This was granted by the Complainant.
 - 3.1.7 On 24 November 2009, the Provider contacted Steven Jerrard, LEADER Panellist ("Panel"), to confirm his availability and that he had no conflict of interest with either party of the Disputed Domain Name. Steven Jerrard confirmed his availability and that he had no conflict of interest.

- 3.1.8 On 27 November 2009, the Provider was contacted by a representative of the Respondent via email and requested a further extension of the response date by 21 calendar days to 15 December 2009 ("Extended Due Date"). This was granted by the Complainant.
- 3.1.9 No response from the Respondent was received by the Extended Due Date.
- 3.1.10 On 22 December 2009, the Panel was informed that the Complaint was being sent for adjudication.

4 Factual Background

- 4.1 The following factual background is accepted by the Panel and is derived from the information in the documents provided to the Panel by the Complainant. No information (contrary or otherwise) was provided by the Respondent.
 - 4.1.1 The Complainant became incorporated as a company on 26 April 1988. The Panel notes that the Complainant was incorporated as Kempville Pty Ltd and subsequently changed its name to Firemex Pty Ltd. The Complainant did not provide the Panel with evidence of the date on which its name was changed.
 - 4.1.2 The Complainant provides fire prevention and protection goods including fire doors, fire door frames, solid core doors, fire rated pillows, fire sealant, fire rated boards and blankets, fire collars and fire rated glazing. The Complainant also provides installation and maintenance services in relation to fire prevention and protection goods.
 - 4.1.3 Since 2 October 2003, the Complainant has been the registered owner of the domain name firemex.com.au ("Firemex Domain").
 - 4.1.4 The Complainant is also the owner of a registered trade mark for "FIREMEX" in Classes 6, 19, 35 and 37 claimed for various fire protection and prevention goods and services ("Firemex Trade Mark").
 - 4.1.5 The Firemex Domain and Firemex Trade Mark have been used continuously to promote the goods and services of the Complainant.
 - 4.1.6 In or around August 2009, the Complainant became aware of the registration and use of the Disputed Domain Name. The Complainant and its solicitors subsequently conducted investigations into the identity of the owners of the Disputed Domain Name and the goods and services provided under it.
 - 4.1.7 The Disputed Domain Name was registered by the Respondent on 17 September 2007 and the registrant's contact is Paul Grimm ("Grimm"). The Complainant provides evidence that Grimm is also the sole director of Firemax Pty Ltd. Firemax Pty Ltd is the corporation carrying on business using the New South Wales Business Name "FIREMAX ESSENTIAL SERVICES" registered on 11 August 2009 for "fire services advisory".

- 4.1.8 As of the date of the Complaint, the Respondent company was subject of a strike-off action. The Complainant's solicitors wrote letters to the Respondent and its sole director, Ian Zacher, requesting that the Disputed Domain Name be transferred to the Complainant. The Complainant received no response to its request.
- 4.1.9 The Respondent company has now been deregistered by ASIC. As a result of its deregistration, the Respondent is not in a position to transfer or deal with the Disputed Domain Name unless it meets the exception set out in Paragraph 5.5 of the Complaints (Registrant Eligibility) Policy (2004-01).
- 4.1.10 The Complainant has made no submissions nor drawn any conclusions to support its Complaint from the strike off action nor impending deregistration of the Respondent.

5. Parties' Contentions

5.1 The Complainant's submissions contend that:

5.1.1 The Disputed Domain Name is identical with or confusingly similar to:

- (i) the Firemex Trade Mark;
- (ii) the Complainant's company name, Firemex Pty Ltd; and
- (iii) the Firemex Domain;

5.1.2 The Respondent has no legitimate right to or interest in the Disputed Domain Name because it does not appear to offer any goods or services under the trade mark FIREMAX.

5.1.3 The Respondent has either registered and/or continued to use the Disputed Domain Name in bad faith because:

- (i) it continued to use an identical or confusingly similar domain name even after it began to receive email correspondence intended for the Complainant's company, Firemex Pty Ltd, and to the Complainant's knowledge, has not taken any steps to mitigate the resultant confusion; and
- (ii) an officer of Firemax Pty Ltd (whom the Complainant contends to also be an agent of the Respondent) had informed the Complainant that it would not forward any emails received in error to the Complainant.

5.2 The Complainant seeks the following relief:

5.2.1 the Disputed Domain Name be transferred to the Complainant; or

5.2.2 the Disputed Domain Name be cancelled.

5.3 Despite requesting two extensions of time in which to provide a response, the Respondent has not submitted any response to the Provider. Therefore the Panel has no documentation or evidence from the Respondent to supplant or counter the information and evidence provided by the Complainant.

6. Discussion and Findings

Elements of a successful complaint

- 6.1 Paragraph 15(a) of the .au Dispute Resolution Policy No. 2002/22 ("auDRP") provides that the Panel shall "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".
- 6.2 Paragraph 4(a) of Schedule A of the auDRP states that a person is entitled to complain about the registration or use of a domain name where:
- (i) The domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights; and
 - (ii) The respondent to the complaint has no rights or legitimate interests in respect of the domain name; and
 - (iii) The respondent's domain name has been registered or subsequently used in bad faith.
- 6.3 It is to be noted that all three elements above must be proved if the Complaint is to be upheld.
- 6.4 In these administrative proceedings, the Complainant bears the onus of proof with regards to each of the separate components required by Paragraph 4(a) of Schedule A.

Is the Disputed Domain Name identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights?

- 6.5 Determinations under the Uniform Dispute Resolution Policy (UDRP) from which the auDRP is derived, have held that when comparing domain names with marks or names, the global top level domain (gTLD) elements of a domain name, such as .com or .net, have no distinguishing capability and may be disregarded when considering whether a domain name is identical or confusingly similar to a name or mark. These determinations are cited and approved in other determinations under the auDRP in respect of open second level domains (2LDs), including *GlobalCenter Pty Ltd v Global Domain Hosting Pty Ltd*, WIPO Case No. DAU2002-2001 (5 March 2003) by a single panellist and *The Crown in Right of State of Tasmania trading as "Tourism Tasmania" v Craven*, WIPO Case NO. DAU2003-0001 (16 April 2003) by a 3-member panel. This Panel therefore also adopts those principles for comparing domain names containing a .com.au element, with a name or mark.
- 6.6 The question to be determined in this dispute is therefore whether the Disputed Domain Name, disregarding its 2LD element, is identical or confusingly similar to the Complainant's company name, Firemex Pty Ltd, the Firemex Trade Mark or Firemex Domain as alleged by the Complainant.
- 6.7 It is noted that Firemex Pty Ltd constitutes a "name" for the purposes of Paragraph 4(a)(i) of Schedule A of the auDRP.

- 6.8 The Complainant has submitted that its Firemex Trade Mark, its company name, Firemex Pty Ltd, and its Firemex Domain are identical with or confusingly similar to the Disputed Domain Name.
- 6.9 The auDRP does not provide guidance as to the intended meaning of "identical" or "confusingly similar". However, previous cases have provided precedent that "identical" can be established by "essential or virtual identity" (*BlueChip InfoTech Pty Limited v Roslyn Jan and Blue Chip Software Development Pty Ltd* [LEADR Case No. 06/03]). The test of what is "confusingly similar" is to be applied in much the same way as the test of "deceptive similarity" in trade mark infringement cases, where the concept of "deception" contemplates consumers who may be deceived or "caused to wonder" about the source or origin of goods or services (*Camper Trailers WA Pty Ltd v Off Road Equipment Pty Ltd* [LEADR Case No. 06/04]).
- 6.10 The Complainant did not provide any reasons why it believes the Disputed Domain Name is identical with or confusingly similar to its company name, Firemex Pty Ltd or the Firemex Trade Mark. However, it can be observed that Firemex Pty Ltd and the Firemex Trade Mark differ from the Disputed Domain Name by a single vowel. Further, it is noted that the Firemex Trade Mark and the Disputed Domain Name are aurally similar.
- 6.11 The Complainant states in its evidence that confusion between its company and the Disputed Domain Name and its associated email addresses have already occurred, and that emails intended for the Complainant have been sent to the Respondent in error. However, the Complainant has not specified how many of such cases of confusion have occurred nor how frequent they may be.
- 6.12 The Panel does not consider the Disputed Domain Name to be identical to the Complainant's company name, Firemex Pty Ltd or the Firemex Trade Mark on the basis that it is spelt differently and has some visual differences. However, given the very minor visual and aural differences, and the confusion that has occurred, the Panel accepts that the Disputed Domain Name is confusingly similar to the Firemex Trade Mark.
- 6.13 Accordingly, the Panel determines that the Complainant has satisfied the requirement of Paragraph 4(a)(i) of Schedule A of the auDRP.

Does the Respondent have any rights or legitimate interests in respect of the Domain Name?

- 6.14 Paragraph 4(a)(ii) of Schedule A of the auDRP requires the Panel to have regard to several matters when considering whether the Respondent has "any rights or legitimate interests" in respect of the Disputed Domain Name.
- 6.15 Paragraph 4(c) of Schedule A of the auDRP provides that the Respondent may establish that it had rights or a legitimate interest in the Disputed Domain Name for the purposes of Paragraph 4(a)(ii), if any of the following circumstances can be proven:
- (i) before any notice to [*the Respondent*] of the subject matter of the dispute, [*the Respondent's*] bona fide use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of

domain names that [*the Respondent*] has acquired for the purpose of selling, renting or otherwise transferring); or

- (ii) [*the Respondent*] (as an individual, business, or other organisation) has been commonly known by the domain name, even if [*the Respondent*] has acquired no trade mark or service mark rights; or
- (iii) [*the Respondent*] is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trade mark or service mark at issue.

6.16 The Panel notes that the above list is a non-exhaustive list of circumstances in which the Respondent may demonstrate its rights or legitimate interests in the Disputed Domain Name. However, any one of the listed reasons above can be taken as examples of how the rights or legitimate interests of the Respondent to the Disputed Domain Name can be demonstrated.

6.17 The Panel notes the New South Wales Business Name Registration for "FIREMAX ESSENTIAL SERVICES" is owned by an entity named "Firemax Pty Ltd". This entity has no relation to the Respondent, other than the fact that the sole director of Firemax Pty Ltd, Paul Grimm, is also the Registrant Contact for the Disputed Domain Name. Paul Grimm is, however, not a director of the Respondent.

6.18 However, Firemax Pty Ltd is not the Registrant on record of the Disputed Domain Name and its existence is irrelevant to the issue of whether the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name unless there is an agreement between the Respondent and Firemax Pty Ltd with regards to the licensing or use of the Disputed Domain Name. No evidence of such an agreement has been provided nor have any assertions been made in this regard.

6.19 The Complainant asserts that the Respondent has no entitlement to the Disputed Domain Name because the Respondent does not appear to offer any goods or services under the trade mark FIREMAX. In the absence of any evidence to the contrary, the Panel accepts the Complainant's evidence in this regard.

6.20 However, the non-offering of goods or services under the name "FIREMAX" is not in itself sufficient to establish that the Respondent has no rights or legitimate interests in the Disputed Domain Name. As noted above, the Respondent may establish rights in the Disputed Domain Name if it was commonly known by the Disputed Domain Name or was making a legitimate non-commercial or fair use of the Disputed Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the name.

6.21 There is no other evidence before the Panel explaining or supporting any assertions as to the Respondent's intended or current use of the Disputed Domain Name.

6.22 In accordance with the auDRP, the Complainant bears the onus of proving that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

6.23 The Panel is not satisfied that the Complainant has discharged this onus and accordingly determines that the Complainant has not satisfied the requirement of Paragraph 4(a)(ii) of Schedule A of the auDRP.

Has the Disputed Domain Name been registered or subsequently used in bad faith?

- 6.24 Paragraph 4(a)(iii) of Schedule A of the auDRP requires that the Disputed Domain Name be registered or subsequently used in bad faith.
- 6.25 Paragraph 4(b) of Schedule A of the auDRP sets out a non-exhaustive list of circumstances which can be taken as "evidence of the registration and use of a domain name in bad faith".
- 6.26 The grounds under Paragraph 4(b) above include:
- (i) circumstances indicating that *[the Respondent]* has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of *[the Respondent's]* documented out-of-pocket costs directly related to the domain name; or
 - (ii) *[the Respondent]* has registered the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or
 - (iii) *[the Respondent]* has registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
 - (iv) by using the domain name, *[the Respondent]* has intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location.
- 6.27 The Complainant argues that the Respondent has either registered or continued to use the Disputed Domain Name in bad faith because:
- (i) it continued to use an identical or confusingly similar domain name even after it began to receive email correspondence intended for the Complainant's company, and had not taken any steps to mitigate the resultant confusion; and
 - (ii) an officer of Firemax Pty Ltd had informed the Complainant that it would not forward on any emails received in error.
- 6.28 The Panel is not satisfied that the continued use of the Disputed Domain Name after the Respondent was aware of the Complainant's company in itself constitutes bad faith as alleged by the Complainant. A copy of the letter sent to the Respondent was not provided to the Panel. No other evidence to this effect was submitted to the Panel.
- 6.29 The Panel considers that it is irrelevant for the purposes of this dispute the actions of Firemax Pty Ltd or its officers. Firemax Pty Ltd is not, on the evidence provided, a party to these proceedings.

- 6.30 The Disputed Domain Name was registered in 17 September 2007. Since the date of registration, there is no evidence before the Panel that the Respondent has offered to sell, rent or transfer the Disputed Domain Name to another party for valuable consideration.
- 6.31 The Complainant has also not provided evidence as to whether the Respondent had used the Disputed Domain Name to intentionally attract, for commercial gain, Internet users to its website or create a likelihood of confusion with the Firemex Trade Mark.
- 6.32 The Panel notes that it is possible that the Respondent may have legitimately registered and used the Disputed Domain Name for a business in a different market to that provided by the Complainant, notwithstanding the similarities between the two names.
- 6.33 The Complainant has stated that it was only aware of the registration and use of the Disputed Domain Name in or around August 2009, whereas the Disputed Domain Name was registered in September 2007. It is compelling that almost 2 years had elapsed before the Complainant was made aware of the Respondent's business or the Disputed Domain Name. It is therefore unlikely that the Respondent had registered the Disputed Domain Name to intentionally attract users to its website.
- 6.34 The Complainant has not provided evidence that the Respondent had registered the Disputed Domain Name primarily for the purpose of disrupting the business or activities of another person, including that of the Complainant. There is no evidence before the Panel that the Respondent was even aware of the Complainant's business at the time of registration or any time prior to the Complainant writing to the Respondent.
- 6.35 The Complainant bears the onus of proof that the Respondent had registered or subsequently used the Disputed Domain Name in bad faith. The Panel is not satisfied that the Respondent had registered nor used the Disputed Domain Name in bad faith.

7. Decision

- 7.1 The Panel concludes for the reasons above that:
- (a) The Disputed Domain Name is confusingly similar to the registered trade mark in which the Complainant has rights;
 - (b) The Complainant has not satisfied the Panel that the Respondent has no legitimate rights in the Disputed Domain Name;
 - (c) The Complainant has failed to establish to the Panel's satisfaction that the Respondent acted in bad faith by registering or subsequently using the Disputed Domain Name.
- 7.2 For the reasons outlined, the Complainant has not satisfied the elements of the auDRP.

8. Relief

8.1 The Panel orders that the Complaint be dismissed.

Dated: 8 January 2010

Steven Jerrard
Sole Panellist